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EXAMINER

HIGGINS, GERARD T

ART UNIT

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1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/560,603

**Applicant(s)**

BENNINGER ET AL.

**Examiner**

GERARD T. HIGGINS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-59 is/are rejected.
- 7) ☒ Claim(s) 22-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendments filed 06/23/2009 and 06/30/2009 have been entered. Currently claims 22-59 are pending and claims 1-21 are cancelled.

### ***Election/Restrictions***

2. Applicants Remarks filed 06/23/2009 and 06/30/2009 are convincing with regard to the rejections of claim 22 based upon the prior art (see section 10 below), and therefore the Examiner has withdrawn his lack of unity restriction between the different groups. Claims 22-59 are now being examined.

### ***Claim Objections***

3. Claims 22, 26, 32-38, 40-47, and 49-59 are objected to because of the following informalities:
  - a. In claim 22, applicants claim on the seventh line that "said body of permanent-magnetic material carries indicia in the form of engravings;" however, this is objected to because it is unclear if this is the same indicia mentioned in the first line of the claim. The objection will be withdrawn if the limitations are changed to "said body of permanent-magnetic material carries ***the*** indicia in the form of engravings," which is how the phrase will be interpreted

- b. In claim 26, the phrase "rare-earth-ironboron" is objected to because it is a typographical error. This objection will be withdrawn if the limitation is changed to "rare-earth-iron-boron," which is how the claim will be interpreted.
- c. In claim 32, on the eighth, ninth, and fifteenth lines of the claim the term "said body" is objected to because it is unclear if this is the same as "said body of permanent-magnetic material." The Examiner interprets the limitation as "said body of permanent-magnetic material" and will withdraw the objection if the limitations are changed to "said body of permanent-magnetic material."
- d. In claim 32, on the ninth line of the claim, applicants claim "said body carrying predeterminable indicia in the form of engravings;" however, this is objected to because it is unclear if this is the same predeterminable indicia mentioned in the first line of the claim and the verb tense is unclear. The Examiner interprets the limitations as "said body *is* carrying *the* predeterminable indicia in the form of engravings."
- e. In claim 32, on the tenth, eleventh, and fifteenth lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.
- f. In claim 33, the phrase "said indicia" is objected because it is unclear if this is the same as "said predeterminable indicia." This objection will be removed if the limitation is changed to "said predeterminable indicia," which is how the limitation will be treated.

- g. In claim 34, the phrase "said body" is objected to because it is unclear if this is the same as "said body of permanent-magnetic material." This objection will be removed if the limitation is changed to "said body of permanent-magnetic material," which is how the limitation will be treated.
- h. In claim 35, on the first, second, and third lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.
- i. With further regard to claim 35, given the rejection of the term "the indicia-carrying surface" outlined in section 5 below, the term "the indicia-carrying surface" in the third line of this claim is objected. This objection will be withdrawn if the term is changed to "the surface," which is how the term will be interpreted.
- j. In claim 36, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.
- k. In claim 36, on the third line of the claim the phrase "permanentmagnetic" is objected to because it is a typographical error. This objection will be withdrawn if the limitation is changed to "permanent-magnetic," which is how the claim will be interpreted.
- l. In claim 37, on the first and second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim

unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.

m. In claim 38, on the first and second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.

n. In claim 40, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

o. In claim 41, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

p. In claim 42, applicants claim on the fourth and fifth lines that the "body of a permanent-magnetic material carrying predeterminable indicia in the form of engravings;" however, this is objected to because it is unclear if this is the same indicia mentioned in the second line of the claim. The Examiner interprets the limitations as "body of a permanent-magnetic material carrying **the** predeterminable indicia in the form of engravings."

q. In claim 42, the phrase "the cylinder" on the sixth line of the claim is objected because it is unclear if this is the same as the "rotatable cylinder." This objection will be withdrawn if the limitation is changed to "the rotatable cylinder," which is how the claim will be interpreted.

- r. In claim 42, on the fifth, tenth, eleventh (two instances), and fifteenth lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.
- s. In claim 42, on the tenth and fifteenth to sixteenth lines of the claim the phrase "said body" is objected to because it is unclear if this is the same as said "body of permanent-magnetic material." This objection will be withdrawn if the limitation is changed to "said body of permanent-magnetic material," which is how the claim will be interpreted.
- t. In claim 43, the phrase "said indicia" is objected because it is unclear if this is the same as "said predeterminable indicia." This objection will be removed if the limitation is changed to "said predeterminable indicia," which is how the limitation will be treated.
- u. In claim 44, on the first, second, and third lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.
- v. With further regard to claim 44, given the rejection of the term "the indicia-carrying surface" outlined in section 5 below, the term "the indicia-carrying surface" in the third line of this claim is objected. This objection will be withdrawn if the term is changed to "the surface," which is how the term will be interpreted.

w. In claim 45, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

x. In claim 46, on the first and second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.

y. In claim 47, on the first and second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.

z. In claim 49, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

aa. In claim 50, on the first line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

bb. In claim 51, the phrase "said body" on the fourth and fifth lines of the claim is objected to because it is not consistent with the previous mentioning of "said body." This objection will be withdrawn if the limitation is changed to "said body of permanently magnetized magnetic material" at each instance, which is how the claim will be interpreted.



cc. In claim 51, on the fifth line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

dd. In claim 52, on the first line of the claim the phrase "Printed product" is objected to because it is grammatically unclear. This objection will be withdrawn if the phrase is changed to "A printed product," which is how the claim will be interpreted.

ee. In claim 52, the phrase "a device according to claim 22" is objected to because it is unclear if this is the same device seen in claim 22. This objection will be withdrawn if the limitation is changed to "**the** device according to claim 22," which is how the claim will be interpreted.

ff. In claim 53, the phrase "Printed product according to claim 52" is objected to because it is grammatically unclear. This objection will be withdrawn if the phrase is changed to "The printed product according to claim 52," which is how the claim will be interpreted.

gg. In claim 54, the phrase "a device according to claim 22" is objected to because it is unclear if this is the same device seen in claim 22. This objection will be withdrawn if the limitation is changed to "**the** device according to claim 22," which is how the claim will be interpreted.

hh. In claim 54, on the fifth line of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

ii. In claim 55, the phrase "A method for producing a device according to claim 54" is objected to because it is unclear if this is the same device seen in claim 54. This objection will be withdrawn if the limitation is changed to "**The** method for producing **the** device according to claim 54," which is how the claim will be interpreted.

jj. In claim 55, on the first to second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

kk. In claim 56, the phrase "A method for producing a device according to claim 55" is objected to because it is unclear if this is the same device seen in claim 55. This objection will be withdrawn if the limitation is changed to "**The** method for producing **the** device according to claim 55," which is how the claim will be interpreted.

ll. In claim 57, the phrase "a device according to claim 22" is objected to because it is unclear if this is the same device seen in claim 22. This objection will be withdrawn if the limitation is changed to "**the** device according to claim 22," which is how the claim will be interpreted.

mm. In claim 57, on the fifth and seventh lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted in each case.

nn. In claim 58, the phrase "A method for producing a device according to claim 57" is objected to because it is unclear if this is the same device seen in claim 57. This objection will be withdrawn if the limitation is changed to "**The** method for producing **the** device according to claim 57," which is how the claim will be interpreted.

oo. In claim 58, on the first to second lines of the claim the phrase "the said" is objected to because usage of both words is superfluous and renders the claim unclear. This objection will be withdrawn if one of either "the" or "said" is deleted.

pp. In claim 59, the phrase "A method for producing a device according to claim 58" is objected to because it is unclear if this is the same device seen in claim 58. This objection will be withdrawn if the limitation is changed to "**The** method for producing **the** device according to claim 58," which is how the claim will be interpreted.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "the coated sheet" in the sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the word "coated" is deleted, which is how the claim will be interpreted.

Claim 32 recites the limitation "the applied ink" in the sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the word "applied" is deleted, which is how the claim will be interpreted.

Claim 32 recites the limitation "the magnetic field" in the seventh line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "a magnetic field," which is how the claim will be interpreted.

Claim 32 recites the limitation "the surface" in the seventh line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "a surface," which is how the claim will be interpreted.

Claim 32 recites the limitation "the oriented magnetic particles" in the thirteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the magnetic or magnetizable particles," which is how the claim will be interpreted.

Claim 32 recites the limitation "the said indicia-carrying surface" in the fifteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the surface," which is how the claim will be interpreted.

Claim 32 recites the limitation "said engraved indicia" in the sixteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said predeterminable indicia," which is how the claim will be interpreted.

Claim 34 recites the limitation "[t]he device" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "[t]he method," which is how the claim will be interpreted.

Claim 35 recites the limitation "the said imprinted or coated first surface" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the first surface," which is how the claim will be interpreted.

Claim 35 recites the limitation "the body of magnetized permanentmagnetic material" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 36 recites the limitation "the magnetic powder" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the permanent-magnetic powder," which is how the claim will be interpreted.

Claim 37 recites the limitation "the said device" in the first and second lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This

rejection will be withdrawn if the limitation is changed to "the body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 38 recites the limitation "the said engraving" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the engravings," which is how the claim will be interpreted.

With regard to claim 42, the term "thin" on the third line of the claim is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what thickness of a plate-like device would be considered thin. The Examiner interprets any

With further regard to claim 42 and the term "plate-like," it has been held that "[t]he addition of the word "type" to an otherwise definite expression (e.g., Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955); likewise, the phrase "ZSM-5-type aluminosilicate zeolites" was held to be indefinite because it was unclear what "type" was intended to convey *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986)." Please see MPEP 2173.05(b), and also please note that the word "like" in this instance (i.e. plate-like) has the same effect as the word "type."

Claim 42 recites the limitation "its surface" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be

withdrawn if the limitation is changed to "a surface," which is how the claim will be interpreted.

Claim 42 recites the limitation "the said engraved surface" in fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the surface," which is how the claim will be interpreted.

Claim 42 recites the limitation "the outer surface" in the sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "an outer surface," which is how the claim will be interpreted.

Claim 42 recites the limitation "the imprinted sheet" in the ninth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the sheet," which is how the claim will be interpreted.

Claim 42 recites the limitation "the printed ink" in the ninth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the ink," which is how the claim will be interpreted.

Claim 42 recites the limitation "the magnetic field" in the tenth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "a magnetic field," which is how the claim will be interpreted.

Claim 42 recites the limitation "the said indicia-carrying surface" in the tenth and fifteenth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the surface," which is how the claim will be interpreted.

Claim 42 recites the limitation "the oriented magnetic particles" in the twelfth and thirteenth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the magnetic or magnetizable particles," which is how the claim will be interpreted.

Claim 42 recites the limitation "said engraved indicia" in the sixteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said predeterminable indicia," which is how the claim will be interpreted.

Claim 44 recites the limitation "the said imprinted or coated first surface" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the first surface," which is how the claim will be interpreted.

Claim 44 recites the limitation "the body of magnetized permanent-magnetic material" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 45 recites the limitation "the magnetic powder" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This



rejection will be withdrawn if the limitation is changed to "the permanent-magnetic powder," which is how the claim will be interpreted.

Claim 46 recites the limitation "the said device" in the first and second lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 47 recites the limitation "the said engraving" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the engravings," which is how the claim will be interpreted.

Claim 51 provides for the use of a device, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 51 recites the limitation "the said indicia-carrying surface" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the surface," which is how the claim will be interpreted.

Claim 51 recites the limitation "said engraved indicia" in the fifth and sixth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said indicia," which is how the claim will be interpreted.

Claim 51 recites the limitation "the coating layer" in the sixth and seventh lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the wet coating layer," which is how the claim will be interpreted.

Claim 51 recites the limitation "said magnetic field" in sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the magnetic field of the body of permanently magnetized magnetic material," which is how the claim will be interpreted.

Claim 52 recites the limitation "said coating layer" in first to second, third, fifth, sixth, and sixth to seventh lines of the claims. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said at least one coating layer," which is how the claim will be interpreted.

Claim 52 recites the limitation "the result" in fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "a result," which is how the claim will be interpreted.

Claim 53 recites the limitation "said product" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said printed product," which is how the claim will be interpreted.

Claim 54 recites the limitation "the body" in the fourth and fifth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will

be withdrawn if the limitation is changed to "the unmagnetized body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 54 recites the limitation "the said surface" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the at least one flat or cylindrically curved surface," which is how the claim will be interpreted.

Claim 54 recites the limitation "the engraved body" in the seventh line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the unmagnetized body of permanent-magnetic material," which is how the claim will be interpreted.

Claim 54 recites the limitation "the indicia-carrying surface" in the eighth line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the at least one flat or cylindrically curved surface," which is how the claim will be interpreted.

Claim 55 recites the limitation "the magnetic powder" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the permanent-magnetic powder," which is how the claim will be interpreted.

Claim 56 recites the limitation "said engraving of indicia" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said engraving of the predeterminable indicia," which is how the claim will be interpreted.

Claim 57 recites the limitation "the body" in fourth and seventh lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the permanently magnetized body of permanent-magnetic material" in each case, which is how the claim will be interpreted.

Claim 57 recites the limitation "the said surface" in fifth to sixth and seventh lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the at least one flat or cylindrically curved surface" in each case, which is how the claim will be interpreted.

Claim 58 recites the limitation "the magnetic powder" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "the permanent-magnetic powder," which is how the claim will be interpreted.

Claim 59 recites the limitation "said engraving of indicia" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. This rejection will be withdrawn if the limitation is changed to "said engraving of the predeterminable indicia," which is how the claim will be interpreted.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 51 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Allowable Subject Matter***

8. It is noted by the Examiner that claims 22-31 would be allowable if rewritten to overcome the objections seen in sections 3a and 3b above.
9. Claims 32-50 and 52-59 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, and the objections set forth in this Office action. See sections 3c-3pp and 5.

#### ***Response to Arguments***

10. Applicant's arguments, see Remarks, filed 06/23/2009 and 06/30/2009, with respect to the rejection of claims 22 and 25-27 under 35 U.S.C. 112, second paragraph and the rejections based upon the prior art references Kashiwagi et al. and Graves have been fully considered and are persuasive. The relevant rejections have been withdrawn.

With regard to the rejection of claims 25 and 27 under 35 USC 112, second paragraph, upon reconsideration the Examiner has withdrawn the rejections because upon a rereading of the claims the limitations contained therein are definite.

Upon reconsideration the Examiner has found applicants' arguments convincing concerning the Examiner's conclusion of *prima facie* obviousness. Applicants are correct in noting that in neither Kashiwagi et al. nor Graves are the engravings provided **directly** in the surface of the body of the permanent magnetic material. The Examiner notes that there is no teaching or suggestion in the prior art, besides the work of the current application, to provide the engravings **directly** in the body of permanent-magnetic material that is permanently magnetized. Such a conclusion of obviousness would not be proper as it would be based upon improper hindsight rationale.

It is noted by the Examiner, albeit a moot point, that the Declaration under 37 CFR 1.132 filed 06/30/2009 is insufficient to overcome the rejection of claims 22-31 based upon Kashiwagi et al. and Graves as set forth in the last Office action because: the comparison does not compare the closest prior art, which is the combination of Kashiwagi et al. and Graves; further, it is noted that the examples prepared in the Declaration are not consistent with those mentioned in applicants' specification. The engraving depth of sample prepared according to the present application has an engraving depth of 0.3 mm; however, the specification has a range of 150 microns to 250 microns (page 17). Having said this, the Examiner does agree that the invention of the present application, comparatively, provides a clearer image in a wet coating of optically variable magnetic pigment flakes versus that of Graves.

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-Th 10am-8pm est. (Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 1795

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Examiner, Art Unit 1794